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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/632,774	08/04/2000	Stacy Haituka	72189/9813B	2126

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EXAMINER


MYHRE, JAMES W

ART UNIT PAPER NUMBER

3622

DATE MAILED: 07/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/632,774	Applicant(s) HAITSUKA ET AL.	
	Examiner James W Myhre	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments, see After Final Response, filed June 30, 2004, with respect to the rejection(s) of claim(s) 1-25 under Lalonde et al (5,283,731), Golden et al (5,761,648), Petrecca et al (5,781,894), West et al (5,845,259), and Wendkos (5,983,196) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Angles et al (5,933,811) and Filepp et al (5,347,632).

Double Patenting

2. Claim 8 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 1. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim 1 is an independent method which includes 7 limitations (a-g). Claim 7 is another independent method claim which includes the first 5 limitations of Claim 1 (a-e). Claim 8 is dependent upon Claim 7 and adds the two limitations (f & g) from Claim 1. Therefore, Claims 1 and 8 contain the same 7 limitations.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1-4, 7-18, 21, 24, and 25 are rejected under 35 U.S.C. 102(e) as being anticipated by Angles et al (5,933,811).

Claims 1, 7, 8, 11, 12, 15, and 21: Angles discloses a system and method for displaying advertisements to a user of an online client device, comprising:

- a. Connecting to an online server (col 7, lines 53-60);
- b. Transmitting and displaying sponsorship label and click-through resource link (col 7, lines 53-60);
- c. Retrieving and displaying a first advertisement from the memory of the local online client device (col 11, lines 50-65);

d. Receiving and displaying a second advertisement from the online server (col 7, line 61 – col 8, line 7).

e. Monitoring the user's interaction with the client window to generate a usage history of the user (col 16, lines 26-37); and

f. Selecting the second advertisement from the remote online server based on the usage history of the user (col 15, lines 25-31).

Claims 2, 9, 13, 16, and 24: Angles discloses a system and method for displaying advertisements to a user of an online client device as in Claims 1, 7, 11, 15, and 21 above, and further discloses the client device establishing a communication link via a public switched telephone network (col 9, lines 3-44).

Claims 3, 10, 14, and 17: Angles discloses a system and method for displaying advertisements to a user of an online client device as in Claims 1, 7, 11, and 15 above, and further discloses the client device requesting and receiving authorization to access the online server (i.e. user logs on)(col 10, line 60 – col 11, line 4 and col 14, lines 9-50).

Claims 4 and 18: Angles discloses a system and method for displaying advertisements to a user of an online client device as in Claims 1 and 15 above, and further discloses the click-through link comprises a uniform resource locator (URL)

associated with an Internet webpage (col 6, lines 32-58, col 7, lines 19-42, and col 15, lines 43-55).

Claim 25: Angles discloses a method for displaying advertisements to a user of an online client device as in Claim 21 above, and further discloses the communication channel comprising a constant connection communication channel, such as interactive television networks or two-way cable systems (col 9, lines 3-44).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 5, 19, 22, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Angles et al (5,933,811).

Claims 5 and 19: Angles discloses a system and method for displaying advertisements to a user of an online client device as in Claims 1 and 15 above, but does not explicitly disclose that the sponsorship label is located on a title bar of the client window. The Examiner notes, however, that Angles presents extensive discussions on how web pages are programmed using the HTML internet protocol language. A standard HTML document defines the location, size, and format where

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each object file is to be displayed on the web page in accordance with the desires of the designer of the web page. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place the sponsorship label at the beginning or top of the web page using a title bar or banner format. One would have been motivated to place the sponsorship label in Angles at the top of the page as a title bar in order to draw the user's attention to this important information.

Claims 22 and 23: Angles discloses a method for displaying advertisements to a user of an online client device as in Claim 21 above, and further discloses the user performing a click-through on the link which causes the remote resource (i.e. website) to be downloaded and displayed to the user. However, Angles does not explicitly disclose that this activity would cause the exit window to be removed. The Examiner notes that since the newly downloaded webpage is being displayed it is inherent that the previous page (exit window) would be removed from the display screen. The Examiner also notes that it is common to display an exit button, normally on the browser's action line, which the user may select to exit from the current window. Clicking on such a button usually takes the user back to a default website or webpage, such as back to the browser's homepage. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide an exit button which leads to an exit page and to delete/remove the exit window when the user clicks on a hyper-link to another webpage such as disclosed by Angles. One would have been motivated to include the exit button and window and to remove the exit window upon selection of a

link by the user in order to allow the user better control over the browsing activity and to clear the window for the display of the selected linked webpage.

7. Claims 6 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Angles et al (5,933,811) in view of Filepp et al (5,347,632).

Claims 6 and 20: Angles discloses a system and method for displaying advertisements to a user of an online client device as in Claims 1 and 15 above, and further discloses displaying a series of advertisements when the user "views a particular electronic page for more than a minute" (col 20, lines 14-17). However, Angles does not explicitly disclose that the additional advertisements are coming from a play list of advertisements specifying the order in which the advertisements are to be displayed. Filepp discloses a similar system and method for displaying advertisements to a user of an online client device in which the downloaded advertisements "may be presented to the user on an individual basis from queues of advertisements". The "Individual queues of advertisements are constructed based upon data collected on the particular applications that were accessed by a user, and upon events the user generated in response to applications" (col 9, lines 30-38). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place the advertisements downloaded in Angles into queues and to present the advertisements in the queue as a series of advertisements. One would have been motivated to use such a queuing system to present the most pertinent advertisement to the user first, then the

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next most pertinent, etc. in order to select the advertisements best suited to entice selection by the user.

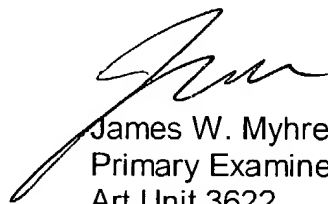
Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. James W. Myhre whose telephone number is (703) 308-7843. The examiner can normally be reached on weekdays from 6:30 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, can be reached on (703) 305-8469. The fax phone number for Formal and Official faxes is (703) 872-9306. Draft or Informal faxes may be submitted directly to the examiner at (703) 746-5544.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (703) 308-1113.


JWM
July 20, 2004


James W. Myhre
Primary Examiner
Art Unit 3622